

REMARKS

Claims 1, 2, and 38-60 were pending. The Examiner allowed claims 2 and 38-60, and rejected claim 1. Applicants have herein amended claims 1, 2, 39, and 52. Support for the amendment to claim 1 can be found at page 3, line 18. Claim 2 has been amended to incorporate the limitations of former claim 1. Claim 39 has been amended to clarify the claim. Claim 52 has been amended to reflect the amendment to claim 1, from which it depends. No new matter has been added. Accordingly, claims 1, 2, and 38-60 are pending.

In light of the amendments and the remarks made herein, Applicants respectfully request reconsideration and allowance of all claims.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claim 1 as being unpatentable over Weinstein *et al.* (U.S. Pat. No. 6,251,452) (hereinafter "Weinstein"). In particular, the Examiner stated that although Weinstein does not teach an edible ink having exactly the same proportions of ingredients as those recited in the instant claims, the Weinstein proportions overlapped with the presently claimed proportions, and the Weinstein ink viscosity range of about 20 to 2000 cps overlapped the instantly claimed viscosity range. Therefore, the Examiner asserted that one having ordinary skill in the art would have been motivated to determine the optimum proportions of ingredients in the disclosed set of ranges to result in an edible ink having the recited viscosity range.

Applicants respectfully disagree. Proper analysis under § 103 requires consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition, and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have had a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Present claim 1 has been amended to recite an edible ink having viscosity of from about 2400 to about 3100 cp at 25 °C. Such a viscosity range does not overlap the Weinstein viscosity ranges at any point. Moreover, Weinstein provides no motivation to modify, nor any suggestion as to how to modify, the proportions of ingredients in its compositions such that an edible ink having a viscosity from

about 2400 to about 3100 cp would result. Accordingly, Applicants respectfully assert that claim 1 is not obvious, and request withdrawal of the rejection.

Allowable Subject Matter

Applicants respectfully note that the Examiner stated on page 3 of the Office Action that claims 38-60 were allowed. In the Office Action Summary page, however, claim 2 was also indicated as being allowed. In addition, on page 3 of the Office Action, the Examiner indicated under point 2) that "an edible ink composition comprising a pigment density of about 0.1 g/l to about 0.25 g/l and an ink density of about 1/1g/l to about 2.0 g/l" was allowable subject matter. Applicants have amended claim 2 to recite the former limitations of claim 1, e.g., an edible ink having a viscosity of about 2000 cp to 16000 cp at 25 °C. Applicants respectfully request clarification from the Examiner as to the status of claim 2.

Applicant : John R. Russell et al.
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CONCLUSION

Applicants respectfully assert that all claims are in condition for allowance, which action is requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution. Applicants also hereby specifically reserve the right to prosecute claims of different or broader scope in a continuation or divisional application.

No fee is believed due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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